REMARKS

Applicant has thoroughly considered the Office action mailed on February 21, 2006. The Office action has indicated that the formal drawings have been accepted. Applicant thanks the Examiner for confirming that the drawings are acceptable. Claims 1-21 are presented in the application for further examination. Claims 1, 6, 7, 8, 13,14, 15, 20 and 21 have been amended by this Amendment A. Reconsideration of the application claims as amended and in view of the following remarks is respectfully requested.

Claims 1, 7-8, 14-15, and 21 have been amended to specify that the format of the textual information comprises two or more byte sequences wherein each sequence comprises an 8-bit character width. Support may be found at paragraphs [0037] to [0053] of the published application.

Claims 6, 13, and 20 have been amended to replace the acronym "MAPI" with the "Messaging Application Programming Interface." Support may be found at paragraph [0029] of the published application.

Claims 1-21 are currently pending. The Applicants respectfully request reconsideration of the application as amended.

I.   Claim Objections

Claims 6, 13, and 20 have been amended to replace the acronym "MAPI" with the "Messaging Application Programming Interface."

II.   35 U.S.C. 112, First Paragraph

Reconsideration is respectfully requested of claims 1-21 as lacking enablement under 35 U.S.C. 112, first paragraph. The Office asserts that "the claim(s) contain subject matter 'greater than 256 characters' which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention."[1] The Office further states

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[1] Office action mailed February 21, 2006, pages 2-3, paragraph 6.

that it "is unsure how an 8-bit character can be greater than 256 characters, when at most an 8-bit character, at most can be 256 characters."[2]

Applicants submit that the claims 1-21, as amended, comprise the phrase "...the format allows for representation of greater than 256 characters using two or more byte sequences of 8-bit character widths..." are fully enabled in view of the specification. One skilled in the art would recognize that a character set having a format that includes a single byte of 8-bits would be limited to 256 characters. The specification, however, discloses a method for persisting an offline address book in a Unicode compatible format.[3] Examples of two Unicode compatible formats include USC-2 and USC-4 which comprise a character format of either two or four byte sequences respectively.[4] The specification further describes the use of UCS Transformation Format-8 (UTF-8) which encodes Unicode characters with a variable number of bytes per character.[5] The specification discloses that "UTF-8 encoded characters may theoretically be up to six bytes long, however 16-bit basic multilingual plane (BMP) characters are only up to three bytes long."[6] Additionally, the specification discloses that "Unicode strings can be represented in 8-bit widths and thus are interpreted as just another multi byte character representation."[7]

For the above reasons, the Applicants respectfully submit that claims 1-21, as amended, are enabled in light of the specification and request withdrawal of the rejection under 35 U.S.C. 112, first paragraph.

III.   35 U.S.C. 103(a)

Reconsideration is respectfully requested of the rejection of claims 1, 5-8, 12-15, and 19-21 under 35 U.S.C. 103(a) as being unpatentable over Huang, US Patent No. 5,966,714, in view of Chin, U.S. Publication No. 20010029455, and further in view of Microsoft Internet Explorer 6 Public Preview Release Notes, hereinafter referred to as "IE6".

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[2]   *Id.*, at page 3, paragraph 6.
[3]   Specification, paragraphs [0016] and [0021].
[4]   *Id.* at paragraph [0039].
[5]   *Id.* at paragraph [0041].
[6]   *Id.* at paragraph [0047].
[7]   *Id.* at paragraph [0053].

For a claim to be *prima facie* obvious under 35 U.S.C. §103 in view of prior art, the prior art references must individually or in combination disclose or suggest all of the limitations of the claim. The references must also suggest or provide a motivation to one skilled in the art to modify the cited references or combine their teachings. Finally, one skilled in the art, upon reading the prior art references, must have a reasonable expectation of success in modifying or combining the references.

A.   *Claims 1, 7-8, 14-15, and 21*

Claims 1, 7-8, 14-15, and 21, as amended, describe a method for persisting, displaying, or searching an offline address book, the method comprising, *inter alia, an* offline address book representing textual information in a format, wherein the format allows for representation of greater than 256 characters using two or more byte sequences of 8-bit character widths.

Huang et al. disclose a method of scaling email address book databases for devices with limited storage. The method includes storing and maintaining a subset of a large address book containing e-mail addresses locally on a client device with limited storage space such as a SmartPhone, personal data assistant, or notebook PC.[8]

Huang et al. do not disclose an offline address book that comprises textual data in a format that allows for representation of greater than 256 characters using two or more byte sequences of 8-bit character widths.

Chin et al. disclose a method for electronically translating text from an input language into target language text.[9] The input language text is initially converted into a generic format. A routing module then selects a translator that provides an optimal translation of the input text in the generic format to the second output language.[10] Chin et al. further disclose that in one embodiment, Java Unicode character strings can be utilized to support output in all supported languages such that the output interface can display languages to users who do not have an operating system that is native to the

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[8] Huang et al., U.S. Patent No. 5,966,714, column 3, line 66 to column 4, line 12.
[9] Chin et al., U.S. Pub. No. 2001/0029455, paragraphs [0105] to [0107].
[10] *Id.* at paragraph [0107].

language of the output.[11] Thus, text that is translated in a foreign language or foreign language text that is translated into the native language of the user can be displayed to an output device.[12]

Chin et al. merely disclose the use of Unicode in the <u>display</u> of non-native language character fonts for information translated from a native language or received from a non-native language source. While Chin et al. disclose that Unicode character strings can be utilized to display non-native languages, they do not disclose a method wherein the Unicode <u>textual information is stored in a structure, such as an address book or other database,</u> that can be searched and subsequently displayed.

The Microsoft Internet Explorer 6 Public Preview Release Notes (hereinafter referred to as "IE6") discloses the transmission of non-English addresses (URLs) encoded in UTF-8 format.

IE6 does not suggest or disclose storing textual information in an offline database or address book. Furthermore, while IE6 discusses problems related to contacts missing in the Windows Address Book, no suggestion is made that UTF-8 could be utilized as the character format for storing textual information contained in the address book. In contrast to promoting the use of UTF-8 character format in address books, IE6 identifies that problems can arise with using such character sets as "<u>many servers cannot process URLs encoded in UTF-8.</u>"[13]

The Applicants respectfully submit that cited references fail to disclose all the elements of the claimed invention, fail to suggest or motivate one skilled in the art to combine the cited references, and fail to provide a reasonable expectation of success in modifying or combining the references.

Neither Huang et al., Chin et al., nor IE6 individually disclose a method wherein an offline address book that comprises textual data in a format that allows for representation of greater than 256 characters using two or more byte sequences of 8-bit character widths.

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[11] *Id.* at paragraph [0134].
[12] *Id.*, see Figure 1.
[13] "Microsoft Internet Explorer 6 Public Preview Release Notes," Published 2001, page 6, last paragraph; http://www.activewin.com/articles/2001/ie6rdme.shtml.

When determining whether a suggestion or motivation to combine references exists, the cited references must be considered in their entirety, including disclosures that teach away from the claimed invention.[14] Huang et al. disclose a method for providing a partial address book to a device with limited storage. One skilled in the art would recognize that utilizing a character format that allows for representation of greater than 256 characters by <u>using two or more byte sequences of 8-bit character widths</u> would at least double the storage requirements of textual information. Furthermore, some UTF-8 encoded characters may be up to six bytes long, requiring six times the storage space for the UTF-8 character versus a single ASCII character.[15] Thus, one skilled in the art reading Huang et al. would not be motivated to combine the reference with another reference disclosing the use of a multi-byte character format which would increase the storage requirements for each character. IE6 also teaches away from using UTF-8 format in an address book by disclosing that many servers cannot process addresses encoded in UTF-8. Thus, one skilled in the art would not be motivated by the IE6 disclosure to incorporate UTF-8 in an offline address book since the disclosure suggests that textual information, such as email addresses, in UTF-8 format would not be able to be processed by many servers, thereby defeating the usefulness of such an address book.

Even if the Huang et al., Chin et al., and IE6 references were combined, one skilled in the art would not have a reasonable expectation of success that the combination would result in the claimed invention. As described above, Huang et al. disclose a method that requires a subset of a larger address book for use on a device that has limited storage. Huang et al. does not disclose storing the address book data in multiple byte character sets. Chin et al. teach a method of translating text of one language into a target language and displaying the text wherein Unicode characters can be utilized to display the non-native language text. Chin et al. and IE6 do not disclose storing textual information in a format, wherein two or more byte sequences of 8-bit character widths are used to represent individual characters. IE6 also teach that many

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[14] *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); MPEP § 2141.03.
[15] Specification, paragraph [0047].

servers cannot process addresses that are encoded in UTF-8 format. Combining the teachings, absent the suggestion or motivation to do so, would not successfully result achieving the method of claims 1, 7-8, 14-15, and 21 which specifies an offline address book representing textual information in a format, wherein the format allows for representation of greater than 256 characters using two or more byte sequences of 8-bit character widths.

For the above reasons the Applicants submit that claims 1, 7-8, 14-15, and 21, as amended, are non-obvious over the cited references and respectfully request withdrawal of its rejections under 35 U.S.C. § 103.

Claims 2-6, 9-13, and 16-20 depend from claims 1, 7-8, 14-15, and 21 and are patentable for the same reasons as those set forth above for claims 1, 7-8, 14-15, and 21 and by reason of the further requirements which they specify.

In view of the foregoing, favorable reconsideration and allowance of all claims is requested.

The Applicants wish to expedite prosecution of this application. If the Examiner deems the claims as amended to not be in condition for allowance, the Examiner is invited and encouraged to telephone the undersigned to discuss making an Examiner's amendment to place the claims in condition for allowance.

Please apply any charges or overpayment to deposit account 19-1345.

Respectfully submitted,

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